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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,489	08/10/2001	Antony Keith Van Dyk	TJK/174	5569
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WILDMAN, HARROLD, ALLEN & DIXON 225 WEST WACKER DRIVE CHICAGO, IL 60606			EXAMINER NORDMEYER, PATRICIA L	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 11/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/831,489

Applicant(s)

VAN DYK ET AL.

Examiner

Patricia L. Nordmeyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 52-87 and 106-120 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 52-87 and 106-120 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Withdrawn Rejections*

1. The 35 U.S.C. 112 rejections of claims 52 – 87 and 106 – 120 of record in Paper #9, Pages 2 – 3, Paragraphs 3 and 4 are withdrawn due to Applicant's amendments in Paper #13.
2. The 35 U.S.C. 102 and 103 rejections of claims 52 – 87 and 106 – 120 of record in Paper #9, Pages 4 – 11, Paragraphs 6 – 13 are withdrawn due to Applicant's amendments in Paper #13.

### *New Rejections*

#### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 52 – 54, 57 – 59, 61 – 68, 71 – 73, 75 – 79, 83, 85, 106 – 109, 111, 114 – 116, 119 and 120 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allbrighton (GB 2,306,429 A).

Allbrighton discloses an anti-skinning layer that prevents the formation of a skin on the surface of paint in a tin (Page 1, lines 2 – 7). Air from the outside environment is prevented from contacting the surface of the paint (Page 1, lines 28 – 31) due to the fact that the insert is contact

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with a portion of the inner surface of the can (Figure 8 and Page 2, lines 25 - 27). However, the formulation vapor is retained within the container in contact with the formulation by spacing the anti-skinning layer away from the surface of the paint (Abstract, lines 2 - 3 and Figure 8). The formulation in the tin is a solvent based gloss paint or any other item which would form a skin on the surface due to the loss of solvent (Page 1, lines 17 - 18 and Page 2, lines 13 - 18). Since the anti-skinning layer could be used for any item that forms a skin on the surface, one of ordinary skill in the art would recognize that the combination of the container and the anti-skinning layer could be used to hold a water-based formulation. One of ordinary skill in the art would also recognize that the formulation has a certain concentration of water and solvent and since the disc blocks the air from contacting the surface of the formulation, the disc would maintain the concentration of both the formulation and the formulation vapor. The disc is formed with a foam lining (Page 3, lines 3 - 6 and Page 6, lines 3 - 12), providing insulation from the outside air. Paint is sold in a variety of size containers including 2.5 liters (Figure 1), thereby requiring a variety of sizes of discs for the containers (Page 7, lines 27 - 32). The disc is removed to use the paint in the can and is placed back into the container when the paint use is finished (Page 2, lines 19 - 29). However, Allbrighton fails to disclose the anti-skinning layer is constructed of material selected from the group consisting of woven polyolefin cloth, unwoven polyolefin cloth, gauze, artificial grass matting and glass fiber felt.

Allbrighton discloses the claimed invention except for the material selected from the group consisting of woven polyolefin cloth, unwoven polyolefin cloth, gauze, artificial grass matting and glass fiber felt. It would have been obvious to one having ordinary skill in the art at

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the time the invention was made replace the foam layer in Allbrighton, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Therefore, one of ordinary skill in the art would readily determine that the foam could be replaced by one of the other selected materials since the material makes the anti-skinning layer lighter and performs an equivalent function to the foam depending on the desired end results and the absence of unexpected results.

Regarding the limitations of the anti-skinning layer being integrally molded or thermally bonded to the internal surface of the container in claims 59, 61, 73, 75, 83, 85 and 119, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113.

5. Claims 52 – 55, 63 – 69, 106 – 109 and 112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al. (USPN 4691,838).

Graham et al. disclose a moist pad in combination with a lid, which prevents the formation of a skin on the surface of paint in a tin (Column 5, lines 10 - 13). Air from the outside environment is prevented from contacting the surface of the paint due to the fact that the

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membrane is contact with a portion of the inner surface of the can and the foil lid (Figure 1, #14 and 16) while allowing the formulation vapors of the paint to gather in the perforations (Figure 1, #17). The formulation in the tin is a solvent based gloss paint or any other item which would form a skin on the surface due to the loss of solvent (Column 4, lines 54 – 55). Since the anti-skinning layer could be used generally for paint, one of ordinary skill in the art would recognize that the combination of the container and the anti-skinning layer could be used to hold a water-based formulation. One of ordinary skill in the art would also recognize that the formulation has a certain concentration of water and solvent and since the disc blocks the air from contacting the surface of the formulation, the disc would maintain the concentration of both the formulation and the formulation vapor. The disc is removed to use the paint in the can and is placed back into the container when the paint use is finished (Column 4, lines 65 – 68). As can be seen by Figures 5 – 8, the membrane of the tray is chosen from a variety of different textures.

6. Claims 52 – 54, 62 – 68, 76 – 79 and 106 – 111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merritt (USPN 5,305,909).

Merritt discloses pusher element, a container sealing means, in combination with a flexible bag, which prevents the formation of a skin on the surface of paint in a tin (Column 2, lines 20 – 28). Air from the outside environment is prevented from contacting the surface of the paint due to the fact that the membrane is contact with a portion of the inner surface of the can and the surface of the paint (Figure 3 and Column 2, lines 20 – 28) while allowing the formulation vapors of the paint to gather in the space between the bag and the side of the

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container (Figure 3, #30). The formulation in the tin is a solvent based gloss paint or any other item which would form a skin on the surface due to the loss of solvent (Column 2, lines 14 – 18). Since the anti-skinning layer could be used generally for paint, one of ordinary skill in the art would recognize that the combination of the container and the anti-skinning layer could be used to hold a water-based formulation. One of ordinary skill in the art would also recognize that the formulation has a certain concentration of water and solvent and since the disc blocks the air from contacting the surface of the formulation, the disc would maintain the concentration of both the formulation and the formulation vapor. The disc is removed to use the paint in the can and is placed back into the container when the paint use is finished (Column 3, lines 49 – 55). The plastic bag has a thickness between 0.00025 and 0.03 inches (Column 3, lines 43 – 45).

7. Claims 60, 74, 80, 81, 84 and 117 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allbrighton in view of Burke et al. (USPN 4,625,883).

Allbrighton discloses the claimed the invention above except for the anti-skinning layer adhering to an internal surface of the container, the container comprising a second anti-skinning layer that extends about at least a portion of an internal surface of the container and the formulation and the second anti-skinning layer being located between a circumferential lip of the container and the water-based formulation.

Burke et al. teach in one embodiment two layers to help prevent air contact with the paint (Figure 1, #10 and 18) where the first layer sits in the grooves at the opening of the can (Figure

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1, #18) while the second layer is in contact with the formulation below the circumferential lip of the container (Figure 1, #10), and in another embodiment of the invention, the anti-skinning layer is adhered to the container in connection with the lid (Column 2, lines 32 – 41 and Figures 4 and 5, #10c) for the purpose of preventing a skin layer from forming on the surface of paint or a similar product in a stored container.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the two layers of anti-skinning material and the grooves or adhering properties in Allbrighton in order to prevent a skin layer from forming on the surface of paint or a similar product in a stored container as taught by Burke et al.

8. Claim 82 is rejected under 35 U.S.C. 103(a) as being unpatentable over Allbrighton in view of Burke et al. as applied to claims 60, 74, 80, 81, 84 and 117 above, and further in view of Graham et al.

Allbrighton, as modified with Burke et al., discloses the claimed invention of an anti-skinning layer in a paint tin except for the second layer being textured.

Graham et al. teaches a membrane with a textured surface (Figures 5 – 8) in a painting tray for the purpose of allowing only a certain amount of paint to be in contact with the roller during the paint process.



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It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the textured surface in the modified Allbrighton in order to allow only a certain amount of paint to be in contact with the roller during the paint process as taught by Graham et al.

9. Claims 86 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allbrighton in view of Gunderson (USPN 5,249,692).

Allbrighton discloses the claimed invention of an anti-skinning layer in a paint tin except for an integrally molded series of space apart concentric ribs integrally molded to a plastics container between the top of the container proximate the sealing means to at least the formulation level and where the integrally molded series of ribs extend from the top of the internal surface of the container proximate to the sealing means substantially to the container base.

Gunderson teaches an anti-skinning layer formed with concentric ribs (Figure 1, #10) that sits between the top of the container and the level of the formulation (Figure 3, #10) for the purpose of keeping the curable liquid from being exposed to air, thereby eliminating skinning when the container is partially full.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the concentric ribs on the anti-skinning layer of

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Allbrighton in order to keep the curable liquid from being exposed to air, thereby eliminating skinning when the container is partially full as taught by Gunderson.

Regarding the limitations of the anti-skinning layer being integrally molded in claim 86, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113.

### ***Response to Arguments***

10. Applicant's arguments with respect to claims 52 – 87 and 106 – 120 have been considered but are moot in view of the new ground(s) of rejection. However, since the same prior art is being used in the new rejections, the arguments will be responded to below.

In response to Applicant's argument that all three Allbrighton, Graham or Merritt fail to disclose an anti-skinning layer that does not exclude the formulation vapor in the container from contacting the water based formulation, all three prior art references discloses pockets of space that are in between the anti-skinning layer and the surface of the water based formulation where the vapors of the formulation would gather. For support from the specification of the prior art, in Allbrighton, see Figure 8 and the Abstract, lines 2 – 3, in Graham see Figure 1, #17 and in Merritt see Figure 3 and Column 2, lines 20 – 28.

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (703) 306-5480. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (703) 308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

*pln*  
pln

*[Signature]*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

11/7/03